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DAVID E. HEISER
E I du Pont de Nemours & Company
Legal Patents
Wilmington DE 19898

In re Application of :
Stephen Ray Foor :Decision on Petition
Serial No.: 10/501,126 :
Filed : 9 July 2004 :
Attorney Docket No.: BA9297USPCT :

This letter is in response to the Renewed Petition under 37 C.F.R. 1.144 filed on 3 March 2008 requesting reconsideration of the lack of unity requirement mailed 17 April 2007.

BACKGROUND

This application was filed as a national stage of a PCT application and as such is entitled to PCT unity of invention rules.

On 17 April 2007, the examiner set forth a lack of unity requirement which divided the claims 1-16 into 12 groups. Claim 1 and claim 6 were placed in part into 9 groups depending upon the second compound (b) of the composition. It is noted that claim 1 and 6 encompassed more than one type of (b) in view of the language "at least compound...." Claim 7 specially required a second type of (b) and was placed in groups I-IV and VI-IX, all partially. The examiner did not require a further election of additional components of (b) as encompassed by original claims 1 and 6 and as required by original claim 7. The examiner did not cite prior art to show that the technical feature did not make a contribution over the prior art instead. Instead, the examiner reasoned that each group required a technical feature not required for another and vice versa.

On 9 May 2007, applicants elected Group II, claims 1, 2 and 6-11, (all partially) and claims 4 and 5 (both complete) with traverse. Applicant also argued that Claim 7 should be included in Group II because the elected compound from (b2) is included in the composition of claim 7.

On 30 May 2007, the examiner set forth a non-final Office action in which Claims 3, 12, 14, 15 and 18-22 were withdrawn from consideration. The examiner considered the traversal and argued that applicants' submission that claim 7 be completely included in Group II was not persuasive because additional compounds were required by claim 7. The restriction requirement was made final. Newly added claims 18-22 were withdrawn from consideration. Claims 1-2, 4-11 and 17 were rejected under 35 USC 103(a) as being unpatentable over Moloney in view of Bereznak and further in view of Jordan. Claims 1 and 4-11 were provisionally rejected over obviousness type double patenting.

On 19 September 2007, applicant responded to the Office action and amended the claim 18 to remove the clause "and optionally at least one component selected from the group consisting of compounds of (b1), (b3), (b4), (b5), (b6), (b7), (b8), and (b9)" and added new claims 23-28.

On 12 December 2007, the examiner set forth a final Office action in which claims 21-23 and 26 were withdrawn from consideration. In view of the amendment to claim 18, Claims 18-20 were rejoined with Group II for examination. The provisional double patenting and obviousness rejections of record were maintained. The obviousness rejection was made on amended claims 18, 19-20, and new claims 24-25 and 27-28. The Office action was made final.

On 3 March 2008, applicants filed this petition.

DISCUSSION

The file history and petition have been considered carefully.

The claims in this application are directed to a composition comprising a compound having Formula I and one or more second compounds of (b), which are listed as (b1), (b2), (b3), (b4), (b5), (b6), (b7), (b8), and (b9). The claims permit one or more second components such that second components may be combined, for example, as (b1) and (b2), (b2) and (b3), etc, etc, all the way up to the entire set of (b1), (b2), (b3), (b4), (b5), (b6), (b7), (b8), and (b9).

The examiner has found unity of invention lacking among the subcombinations of (b1), (b2), (b3), (b4), (b5), (b6), (b7), (b8), and (b9), however the lack of unity did not provide applicants an opportunity to elect a combination such as those set forth in claims 6 and 7. Applicants elected the composition comprising a compound having Formula I and the second compound of (b2). All claims which do not require the elected subcombination of (b2) have been cancelled.

Applicant also has presented claims which to a composition having Formula I, a second component of (b2) and optionally recite other non-elected compounds in addition to the elected (b2).

In the final Office action, the examiner withdrew new claim 26 from examination while at the same time, providing an examination of claims 6 and 7. Claim 26 and claims 6 and 7 are set forth below. Applicants reasonably ask how claims 6 & 7 can reasonably be included in the examination while claims 21-23 are not.

6. (Currently amended) The composition of Claim 1 wherein component (b) comprises at least one compound selected from (b2) and at least one compound each of two different groups selected from (b1), ~~(b2)~~, (b3), (b4), (b5), (b6), (b7), (b8) and (b9).

7. (Original) The composition of Claim 6 wherein component (b) comprises at least one compound selected from (b2) and at least one compound selected from (b1), (b3), (b6), (b7), (b8) or (b9); wherein the overall weight ratio of component (b) to component (a) is from 30:1 to 1:30; and wherein the weight ratio of component (b2) to component (a) is from 10:1 to 1:1.

26. (New) The composition of Claim 24 further comprising at least one compound selected from the group consisting of

- (b1) alkylenebis(dithiocarbamate) fungicides;
- (b3) cymoxanil;
- (b4) compounds acting at the demethylase enzyme of the sterol biosynthesis pathway;
- (b5) morpholine and piperidine compounds that act on the sterol biosynthesis pathway;
- (b6) phenylamide fungicides;
- (b7) pyrimidinone fungicides;
- (b8) phthalimides; and
- (b9) fosetyl-aluminum.

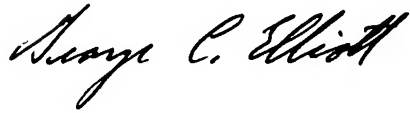
The lack of unity requirement divided the claims 1-16 into 12 groups. Claim 1 and claim 6 were placed in part into 9 groups depending upon the second compound (b) of the composition. It is noted that claim 1 and 6 encompassed more than one type of (b) in view of the language "at least compound...." Claim 7 specially required a second type of (b) and was placed in groups I-IV and VI-IX, all partially. The examiner did not require a further election of additional components of (b) as encompassed by original claims 1 and 6 and as required by original claim 7. Nor did the examiner clearly specify that combination claims would not be examined with the elected subcombination. Applicant was not properly afforded an opportunity to elect the invention present in original claims 6 and 7 and in newly added claims 21-23 and 26.

DECISION

The petition filed under 37 CFR 1.144 on 3 March 2008 is **GRANTED** to the extent that applicant has not been properly afforded an opportunity to select an invention present in original claims 6, 7, and in newly added claims 21-23 and 26.

The Final Office action of December 12, 2007 will be vacated and the application returned to the examiner for consideration of the papers filed 3 March 2008 and for preparation of a revised lack of unity consistent with this petition decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-272-8300.

A handwritten signature in cursive script, reading "George C. Elliott". The signature is written in black ink and is positioned above the printed name and title.

George Elliot
Director, Technology Center 1600